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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,733	07/21/2003	Brian T. Kobashikawa	08226/1201530-US1	7188
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DARBY & DARBY P.C. P.O. BOX 5257 NEW YORK, NY 10150-6257				
			EXAMINER LIN, SHEW FEN	
			ART UNIT 2166	PAPER NUMBER

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/624,733	KOBASHIKAWA ET AL.	
	Examiner	Art Unit	
	Shew-Fen Lin	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/21/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- a. This action is responsive to application filed on 7/21/2003.
- b. The application claims priority to the provisional application, 60/456616 (filed on 3/21/2003).
- c. Claims 1-20 are pending. Claims 1, 9, 16, and 18 are independent claims.

Claim Rejections – 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV. B.2. (b)

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan (discussed in i) below), or (B) be limited to a practical application within the technological arts.

Claims 1-15 in view of the above-cited MPEP section are not statutory because they merely recite steps that can be performed by a person with pen and paper. The use of a computer or a data processor has not been indicated being used to perform the steps. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result a practical application

Art Unit: 2166

producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101 nor is there a transformation of something physical to another state or thing.

Claim Objections

Claim 2 is objected to because of the following informalities: It is unclear how “in” field and “sent “ field relative the e-mail. It is suggested that common field names used by most e-mail system, like “from” and “to”, should be used. Appropriate correction is required.

Claims 19 and 20 are objected to because of “a method “ cannot be the dependent claim(s) of “a computer readable medium”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-13 and 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Harms et al. (US Publish 2003/0078981, hereinafter referred as Harms).

Art Unit: 2166

As to claims 1, 16, and 18, Harms discloses a method/system/apparatus for use in populating an electronic address book (contact list reads on address book, paragraph [0021], lines 1-2), comprising:

searching through at least one archive of e-mails for an e-mail address (search new message or messages in database, Figures 2-3, paragraph [0026], lines 2-6) ;

evaluating the e-mail address based on a first defined criterion (find new e-mail address, Figures 2-3, paragraph [0037], lines 3-6, paragraph [0045], lines 2-4), ; and

adding the e-mail address to an address book if the first criterion is satisfied (add e-mail address automatically or after approval, paragraph [0031]).

As to claims 2 and 17, Harms discloses the elements of claim 1 as noted above and further discloses wherein the searching includes searching an "In" field, a "sent" field and a "cc" field (Figure 6, paragraph [0035], lines 5-11).

As to claim 3, Harms discloses the elements of claim 1 as noted above and further discloses wherein the evaluating includes determining if the e-mail address already exists in the address book, and not adding the e-mail address in the address book if it already exists in the address book (only select the address not in the contact list, paragraph [0037], lines 3-6).

As to claims 4 and 19 Harms discloses the elements of claims 1 and 18 as noted above and further discloses wherein the evaluating includes evaluating the e-mail address based on a second defined criterion (filter address to include message from specified domains as second

Art Unit: 2166

criterion, Figure 6, paragraph [0035], lines 11-16); and the adding includes adding the e-mail address to the address book if both the first and the second criterion are satisfied (new e-mail address comes from specified domain will be added, Figures 2 and 6, paragraph [0036]) and not adding the e-mail address to the address book unless both the first and second criteria are satisfied (existing e-mail address or not comes from specified domain will not be added, Figures 2 and 6, paragraph [0036]).

As to claim 5, Harms discloses the elements of claim 1 as noted above and further discloses determining if the archive from which the e-mail address was retrieved includes an organization (database, paragraph [0025], lines 8-9); organizing the address book according to at least a portion of archive from which the e-mail address was retrieved (organize based on last name, Figure 4); and the adding includes adding the e-mail such that the e-mail address is added according to the organized address book (Figure 4, paragraph [0027]).

As to claim 6, Harms discloses the elements of claim 1 as noted above and further discloses generating a retrieved list of e-mail addresses retrieved during the searching that satisfy the first criterion (new address is found, paragraph [0037], lines 3-6); and the adding includes adding the e-mail addresses if the e-mail address is confirmed to be added (Figure 4, paragraph [0031], paragraph [0033]).

As to claim 8, Harms discloses the elements of claim 1 as noted above and further discloses receiving confirmation of additions based on the retrieved list prior to the adding the e-

Art Unit: 2166

mail address (select e-mail to enter from list of new address, Figure 4, paragraph [0027], paragraph [0033]).

As to claim 9, Harms discloses a method for use in generating and maintaining an address book, comprising:

accessing an electronic archive containing e-mail addresses (monitor incoming message or scan message database, Figures 2-3);

searching the archive for the e-mail addresses (search e-mail address and/or name, Figures 2-3, paragraph [0026], lines 2-6);

retrieving one or more e-mail addresses (find e-mail address, Figures 2-3, paragraph [0027], lines 1-5);

applying a first criterion to a first retrieved e-mail address (check to see e-mail existing in contact list, Figure 2, paragraph [0037], lines 3-6); and

adding the first retrieved address to an electronic address book if the first criterion is met (add e-mail address automatically or after approval, paragraph [0027], paragraph [0031]).

As to claim 10, Harms discloses the elements of claim 9 as noted above and further discloses wherein the applying includes applying a second criterion to the first retrieved address (filter address to include message from specified domains as second criterion, Figure 6, paragraph [0035], lines 11-16); and the adding includes adding the first retrieved address to the electronic address book if both the first and second criteria are met (new e-mail address comes from specified domain will be added, Figures 2 and 6, paragraph [0036]).

As to claim 11, Harms discloses the elements of claim 10 as noted above and further discloses supplying a plurality of criteria options (filter rules reads on criteria, Figure 6, paragraph [0026], lines 6-14, paragraph [0035], lines 1-5); and receiving a selection of criteria including the first and second criteria (criteria can be user defined and selected, paragraph [0021], lines 6-14).

As to claim 12, Harms discloses the elements of claim 10 as noted above and further discloses wherein the archive includes an archive of e-mails (message in database or storage device, Figure 3, paragraph [0030], lines 1-2); and the searching includes searching a plurality of fields associated with each e-mail of the archive (plurality of fields - "From Field", "To Field", and "CC Field", paragraph [0035], lines 5-11).

As to claim 13, Harms discloses the elements of claim 12 as noted above and further discloses accessing an external archive associated with an external device (paragraph [0030], lines 1-2);

searching the external archive for e-mail addresses (Figure 3);

retrieving e-mail addresses from the external archive (Figure 3, paragraph [0030]);

applying the first and second criteria (filter address to include message from specified domains as second criterion, Figure 6, paragraph [0035], lines 11-16); and

Art Unit: 2166

adding the retrieved e-mail addresses from the external archive if the retrieved e-mail addresses from the external archives meet both the first and second criteria (new e-mail address comes from specified domain will be added, Figures 2 and 6, paragraph [0036]).

As to claim 15, Harms discloses the elements of claim 9 as noted above and further discloses generating a nickname in association with the first e-mail address (display name reads on nickname, abstract, lines 2-6); and adding the nickname associated with the first e-mail address to the address book (abstract, lines 6-8).

As to claim 20, Harms discloses the elements of claim 19 as noted above and further discloses a code segment for supplying a plurality of criteria options (different filter rules can be applied, Figure 6, paragraph [0035]); and a code segment for receiving a selection of criteria including the first and second criteria (select criteria/rules from fields, domain, Figure 6, paragraph [0035]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harms as applied to claim 1 above, and further in view of Creswell et al. (US Patent 6,564,264, hereinafter referred as Creswell).

As to claim 7, Harms discloses the elements of claim 1 as noted above but does not explicitly disclose generating a verification list of at least the e-mail address added to the address book

Creswell discloses verifying the user with message with the updated address information (Figures 2 and 3, column 2, lines 48-55, lines 63-64, column 4, lines 51-57).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Harms's disclosure to include verification of updated e-mail address as taught by Creswell for the purpose of confirmation of updated e-mail address (Figure 3, item 307, Creswell). The skilled artisan would have been motivated to improve the invention of

Art Unit: 2166

Harms per the above such that address book can be updated without manual, time-consuming process (abstract, Creswell).

Claim 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harms in view of Cortright et al. (US Patent 6,895,426, hereinafter referred as Cortright).

As to claim 14, Harms discloses the elements of claim 12 as noted above and further discloses

determining if the archive includes an organizational folder (database, paragraph [0025], lines 8-9);

the adding includes adding the first e-mail address to the electronic address book in the generated folder (Figure 4, paragraph [0027]).

Harms does not explicitly disclose determining if the e-mail address was retrieved from the organization folder; generating a folder within the addresses book; and adding the first e-mail address to the electronic address book in the generated folder.

Cortright discloses determining if the e-mail address was retrieved from the organization folder (provide icon to identify where the e-mail address was retrieved; person, list, newsgroup, test, or address. Figures 4A/B, 5A/B, Figure 9, column 4, lines 44-67, column 8, lines 1-43). Cortright also discloses generating a folder within the addresses book and add e-mail address to the folder (column 10, lines 26-44, lines 55-61).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Harms's disclosure to identify the status /source of e-mail address as taught

Art Unit: 2166

by Cortright for the purpose of providing appropriate icon for the use to manipulate the address (column 2, lines 57-67, column 3, lines 1-3, Cortright). The skilled artisan would have been motivated to improve the invention of Harms per the above such that address book can be updated without manual, time-consuming process (column 3, lines 4-8, Cortright).

Related Prior Arts

The following list of prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Nishio, Takeshi et al., US 20030037114 A1, "System, method and apparatus for updating electronic mail recipient lists", (...a plurality of e-mail addresses to which given e-mail is sent/receive is compared to contact list to update e-mail address...).
- Caughey, David A., US 20040059784 A1, "Automatic highlighting of new electronic message address", (...providing an electronic message including address data ... identifying the address data within the provided electronic message; comparing address data within the provided electronic message with address data stored on the computer within an address list; providing a notification to the user when a result of the comparison indicates that at least some of the identified address data is other than within the address data, the notification other than a prompt to add the identified address data to the further address data.)

Art Unit: 2166

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 2166
January 15, 2006

Shew-Fen Lin
Patent Examiner


MOHAMMAD ALI
PRIMARY EXAMINER